

**R E M A R K S**

Prior to entry of this Amendment:

- Claims **70-79 and 81-90** were pending
- Claims **70-79 and 81-90** stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **70-79 and 81-90** will be pending (20 total claims)
- Claims **70, 73, 76, 77, 81 and 83** will be amended
- Claims **70, 73, 76-79, 81 and 83** will be the only independent claims (8 independent claims)

**A. Telephone Interview**

We are grateful for the Examiner's courtesy in allowing a Telephone Interview, held October 21, 2004, with our representative.

The Examiner and our representative discussed the Section 101 rejections of Claims **70-79 and 81-90**.

Our representative stated that Claims **78 and 79** are not indefinite or non-statutory, but are directed (in a fairly conventional manner) to media including instructions for directing a computer to perform defined steps. Our representative explained that the recited steps are descriptive of the instructions encoded with the recited media and thus define the recited media.

The Examiner did not formally agree that Claims **78 and 79** are definite and statutory but did agree to consider these arguments (discussed further below), for which we are grateful.

Our representative and the Examiner discussed proposed amendments to independent Claims **70, 73, 76, 77, 81 and 83**. We are grateful that the Examiner indicated that the proposed amendments (which we have adopted in this Amendment) would overcome the Examiner's Section 101 rejection of those claims. [Examiner's Interview Summary of October 26, 2004].

**B. Claim Amendments****B.1. Independent Claims 70, 73, 76, 77, 81, and 83 have been amended**

No new matter has been added.

Although we do not believe that any amendment is necessary in order for any claim to be statutory under § 101, each of independent Claims **70, 73, 76, 77, 81, and 83** has been amended, as discussed with the Examiner during the Telephone Interview, to include a feature of *a computer* (Claims **70, 73, 81 and 83**) or computer means (Claims **76 and 77**). We submit that independent Claims **70, 73, 76, 77, 81, and 83** (and claims dependent therefrom) contain allowable subject matter.

This Amendment is made without prejudice and solely in order to expedite allowance of the present application and to avoid the well-known delay incurred by the appeals process. We reserve the right to pursue originally-filed subject matter in a continuing application.

**C. Section 101 Rejections**

The Examiner rejects all of the pending claims (Claims **70-79 and 81-90**) as being directed to non-statutory subject matter under Section 101. We do not agree with the Section 101 rejection.

We are grateful that the Examiner has indicated that all of the claims (Claims **70-79 and 81-90**) are directed to useful, concrete and tangible results, which we believe is the only proper requirement for statutory subject matter under § 101.

**C.1. Claims 70-77 and 81-90**

As discussed above and with the Examiner during the Telephone Interview, each of independent Claims **70, 73, 81 and 83** has been amended to recite generally a feature of *a computer* in the body of the claim. Each of independent Claims **76 and 77** has been amended to recite generally a feature of *computer means* in the body of the claim.

We submit that each of Claims **70-77 and 81-90** is directed to statutory subject matter and is in condition for allowance.

**C.2. Claims 78 and 79**

Claims **78 and 79** are rejected under § 101 as embracing more than one statutory class. [Office Action, pages 5-6]. The Examiner asserts that the preamble “should clearly define whether the claims are a system or a method.” [page 6].

Contrary to the Examiner’s assertion, the preambles of Claims **78 and 79** do clearly indicate that the claims are directed to computer-readable storage media (articles of manufacture), and not to methods.

As discussed with the Examiner during the Telephone Interview, the language of Claims **78 and 79** (each reciting a medium including instructions for directing a computer to perform defined steps) is directed to statutory subject matter and is believed to be a fairly conventional way to claim a medium that is encoded with instructions for directing a computer to perform particular steps.

In Ex parte Lyell (17 USPQ2d 1548), cited by the Examiner in support of the rejection, the applicant recited elements to define a tool, and in the same claim also recited steps describing a method of using the claimed tool.

In contrast, it is clear that Claims **78 and 79** claim computer-readable storage mediums (with particular encoded processing instructions), not methods. We do not recite an article of manufacture and then recite a method of using the article, as in Lyell. Instead, the steps noted by the Examiner are descriptive of the instructions encoded with the medium, which are for directing a computer to perform in a particular way. The recited steps simply define the instructions that are encoded on the medium, thereby defining the claimed computer-readable storage medium (article of manufacture).

We note that each of Claims **78 and 79** is directed to a computer-readable storage medium encoded with processing instructions for directing a computer to perform particular steps. Accordingly, Claims **78 and 79** would appear to comply with the Examiner’s extraneous requirement that every claim be related to activity of a computer.

If the Examiner would like to discuss Claims **78 and 79** further, we encourage the Examiner to contact the undersigned at the earliest convenience.

We submit that each of Claims **78 and 79** is directed to statutory subject matter and to only one statutory class (article of manufacture). Accordingly, we respectfully request that the Examiner withdraw the Section 101 rejection of Claims **78 and 79**.

#### **D. Section 112 Rejection**

The Examiner has also rejected Claims **78 and 79** under § 112, second paragraph, as being indefinite “due to the combining of two separate statutory classes of invention in a single claim.” [Office Action, page 2].

As discussed above with respect to the Section 101 rejection of Claims **78 and 79**, the language used in Claims **78 and 79** is fairly conventional and explicitly claims computer-readable storage media encoded with particular processing instructions for directing a computer to perform the defined steps, and thereby the claims define articles of manufacture. Thus, Claims **78 and 79** are each directed to only one statutory class of invention (article of manufacture).

The Examiner also asserts that “the body of the claim begins by discussing the specifics of what appears to be a system...then the claims subsequently deal with the specifics of a method...directing the computer for performing the steps.” [Office Action, page 2].

We do not understand why the Examiner states that some of the steps are “specifics of what appears to be a system....” Clearly, all of the recited steps (*generating, producing and distributing*) are steps to be performed by a computer as directed by the processing instructions. Similarly, we do not understand why the Examiner believes that only some of the steps “subsequently deal with...directing the computer for performing the steps”: all of the recited steps are steps that the instructions are for directing a computer to perform.

We respectfully request clarification of why the Examiner finds that one having ordinary skill in the art would have interpreted the language as the Examiner has done.

We dispute the Examiner’s assertion that any language of Claims **78 and 79** would be unreasonably unclear to one having ordinary skill in the art under § 112, second paragraph. The claims are clearly and explicitly directed to computer-readable storage media encoded with particular processing instructions that are defined in part by the recited steps that the instructions are for directing a computer to perform.

If the Examiner would like to discuss Claims **78 and 79** further, we encourage the Examiner to contact the undersigned at the earliest convenience.

We respectfully request that the Examiner withdraw the § 112, second paragraph, rejection of Claims **78 and 79**.

**E. Response to Arguments**

We do not agree that any of the present amendments is necessary in order to be statutory under § 101. Specifically, we do not agree that it is proper to reject any claim under § 101 merely because “[t]he claims do not have a computer performing the method in the preamble or a user accessing information at the computer or selecting the computer for the generation of a certificate identifier.” [Office Action, page 4]. Under relevant case law, there is no requirement that any claim recite a “computer” or any other type of physical limitation in order to be statutory. The reciting of physical limitations, for example, may be helpful, but is not necessary to render a claim statutory. AT & T Corp., 172 F.3d at 1359 (“Whatever may be left of the earlier test, if anything, this type of physical limitations analysis seems of little value....”). Even where a claim incorporates a mathematical algorithm, in contrast to focusing on a physical limitations inquiry, the inquiry deemed the “ultimate issue” “focuses on whether the mathematical algorithm is applied in a practical manner to produce a useful result.” AT & T Corp., 172 F.3d at 1359-60. Accordingly, to the extent that the Examiner is now making a requirement out of something that is explicitly “of little value” (i.e., whether the claim explicitly relies on use of a “computer”) to the “ultimate issue” of whether a claim is directed to statutory subject matter, the § 101 rejections are improper.

**F. Conclusion**

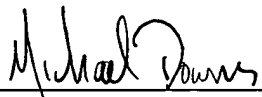
It is submitted that all of the claims (Claims **70-79 and 81-90**) are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

Respectfully submitted,

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Date

  
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Michael Downs  
Attorney for Applicants  
Registration No. 50,252  
[mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com)  
(203) 461-7292 /voice  
(203) 461-7300 /fax